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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,507	02/23/2004	Ken Rosenblum	1326.001US5	1482

21186 7590 06/01/2007

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EXAMINER	
MAI, THIEN T	

ART UNIT	PAPER NUMBER
2876	

MAIL DATE	DELIVERY MODE
06/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

TH

Office Action Summary	Application No.	Applicant(s)	
	10/784,507	ROSENBLUM, KEN	
	Examiner	Art Unit	
	Thien T. Mai	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement

1. Acknowledgement is hereby made of the Amendment received on 02/21/2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim(s) 1-3 and 6-10 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoonen (US 6,230,927) in view of Monich et al. (US 6,335,907)

Regarding claim(s) 1, Schoonen discloses a method comprising:

giving the unique one-time drug identification code as the authorization code for multiple drugs in a prescription by a doctor stored on customer's chip card or transmitted to the server computer at a pharmacy location where the automatic dispenser is located, wherein said authorization code can be used to obtain one time for a single prescription for drugs that are prepackaged in cartridge for the customer/patient to pickup when the patient/customer enters said authorization code into the dispenser without intervention of a pharmacist; wherein the doctor can be interpreted as being a

healthcare provider at a health care facilities such as hospital or a physician's office (see abstract, col. 1 lines 20-65, col. 7 lines 1-5).

Schoonen lacks the authorization code not being reused for other prescription.

Momich et al. disclose that "usually a prescription from a physician includes: name of medication and dosage/strength, number of pills (or some other measure of quantity) and frequency, number of repeats allowed, name of user, prescribing doctor, date issued" (col. 12 lines 10+).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an authorization code issued by a doctor on a card having a prescription issued date as taught by Momich et al. for comparison in obtaining prescription to avoid stealing from unscrupulous or drug dependent individuals who may steal/snatch the card from the patient to obtain drugs.

Regarding claim(s) 2, Schoonen discloses the patient receives the prescribed therapeutic agent from the dispensing apparatus without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 3, Schoonen discloses unique authorization code is given to the patient by a health care provider at a health care facility. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 6, Schoonen discloses the unique authorization code is unique to the prescription and only associated with a single prescription. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 7, Schoonen discloses a method comprising:

providing a dispenser containing an inventory of therapeutic products; transmitting a proposed prescription for a patient to a server; authorizing dispensing of at least a portion of the proposed prescription out of the inventory in the dispenser if the prescription includes at least one therapeutic product available in the inventory of the dispenser; providing to the patient an authorization code unique to the authorized prescription, the authorization code not capable of being reused for other prescriptions; the patient inputting the authorization code into the dispenser; and the dispenser delivering the available therapeutic product to the patient in response to the patient inputting the authorization code. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Schoonen lacks the authorization code not being reused for other prescription.

Momich et al. disclose that "usually a prescription from a physician includes: name of medication and dosage/strength, number of pills (or some other measure of quantity) and frequency, number of repeats allowed, name of user, prescribing doctor, date issued" (col. 12 lines 10+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an authorization code issued by a doctor on a card having a prescription issued date as taught by Momich et al. for comparison in obtaining prescription to avoid stealing from unscrupulous or drug dependent individuals who may steal/snatch the card from the patient to obtain drugs. The combined teachings of Schoonen/Nomich would result in the patient inputting the authorization code into the dispenser and the patient entering separate (interpreted as being different or distinct from - see dictionary.reference.com) patient authorization date into the dispenser; and the dispenser determining whether the authorization code

correlates to the patient authorization date (by comparing the its signal having known correlated/related information about the patient including authorization and date therein with that from the card)

Regarding claim(s) 8, Schoonen discloses the authorization step is done without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 9, Schoonen discloses the patient receives the therapeutic agent from the dispenser without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 10, Schoonen discloses the authorization code is given to the patient by a health care provider at a health care facility.

4. Claim(s) 4-5 and 11 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoomen (US 6,230,927), modified by Monich et al. (US 6,335,907), further in view of Lion (US 4,732,411). The teachings of Schoonen have been discussed above.

Regarding claim(s) 4, Schoonen discloses the authorization code is given to the patient by a doctor (see abstract, col. 1 lines 20-37, col. 7 lines 1-5).

Schoonen does not disclose or fairly suggest the authorization is given to the patient by a pharmacist.

Lion discloses an automatic prescription dispenser for dispensing prescription drug without intervention of a local operator, wherein the dispenser receives a pre-

assigned identification as the authorization code through a mail order pharmacy, which inherently implies the pharmacy having at least a technician/pharmacist performing the function of assigning the authorization code to the patient; wherein the dispenser also receives payment in the form of debit or credit card (col. 3 lines 27-40, col. 6 lines 1-10, col. 6 lines 35-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Lion's teachings to Schoomen by assigning a unique and single use prescription identification by a pharmacy technician or pharmacist.

One of ordinary skill in the art should be motivated to employ the pharmacy-assigned prescription identification as taught by Lion so that traffic at the pharmacy can be alleviated and customer wait time for the prescription fill status can be minimized by entering the authorization code in the dispenser for the prescription rather than continuously requesting the status from the pharmacy staff.

Regarding claim(s) 5, Lion discloses the dispenser also receives payment in the form of debit or credit card (col. 3 lines 27-40, col. 6 lines 1-10, col. 6 lines 35-50).

Regarding claim(s) 11, Lion discloses the authorization code is given to the patient by a pharmacist or pharmacy technician at a pharmacy (col. 3 lines 27-40, col. 6 lines 1-10, col. 6 lines 35-50).

5. Claim(s) 12-13, 15-6 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoomen (US 6,230,927) in view of Williams et al. (US 6,036,812) and Chudy (US 6,370,841)

Regarding claim(s) 12, Schoonen discloses a method comprising

giving the unique one-time drug identification code as the authorization code for multiple drugs in a prescription by a doctor stored on customer's chip card or transmitted to the server computer at a pharmacy location where the automatic dispenser is located, wherein said authorization code can be used to obtain one time for a single prescription for drugs that are prepackaged in cartridge for the customer/patient to pickup when the patient/customer enters said authorization code into the dispenser without intervention of a pharmacist; wherein the doctor can be interpreted as being a healthcare provider at a health care facilities such as hospital or a physician's office (see abstract, col. 1 lines 20-65, col. 7 lines 1-5)

wherein the dispenser is authorized to dispense the whole prescription out of the dispenser's inventory if the prescription drug is available for dispense, otherwise the patient will receive nothing; and wherein the authorizing is done by the doctor who saves the prescription in the patient's card, therefore intervention by pharmacist is unnecessary (see abstract, col. 1 lines 20-65, col. 7 lines 1-5).

wherein before delivery, the dispenser checks the cartridge 1 (Fig. 1A-B) identification code and the drug identification code inherently associated with the drug stored in the cartridge and conveyed by a gripper/resilient finger 14, 39controlling means (col. 2 lines 35+, Fig. 1A-B, 3A)

Schoonen further does not teach or fairly suggest the dispenser labeling the therapeutic product with information unique to the adjudicated prescription. **Williams** et al. teach a dispenser (Figure 6A) having a robotic arm 25 that places the pill bottle 50

on label printer and applier 54 so that the prescription label with desired patient and prescription information can be included on the label that is printed and applied to the bottle 50. The label gets the information to be printed on the label such as patient name, drug, and instructions from computer 44. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Williams et al. so that the labeling time is freed up for the pharmacy technician or pharmacist to perform other work. Also, the use of the robot for labeling the prescription containers prevents contamination of prescription caused by the adhesive in the labels when being handled.

Schoonen/Williams is unclear with respect to the labeled information is unique with adjudicated prescription. **Chudy** discloses a label having a barcode with customized information unique to a prescription and tailored to operator's needs; the label can have hospital name, doctor's name, and other patient-specific information (Fig. 23-24, col. 24 lines 25+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Chudy's teachings so that information other than the adjudicated prescription can be read by pharmacy technicians so that in case when the patient is in need of, for example emergency medical attention or an language interpreter, appropriate actions is taken.

Regarding claim(s) 13, Schoonen discloses the data includes a one-time-use authorization code associated with only the adjudicated prescription. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 15, Schoonen discloses the therapeutic product is delivered to the patient without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Re claim(s) 16, Schoonen discloses adjudicating the proposed prescription into an adjudicated prescription is done without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

6. Claim(s) 14 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoomen (US 6,230,927), modified by Williams et al. (US 6,036,812) and Chudy (US 6,370,841), further in view of Monich et al. (US 6,335,907). The teachings of Schoonen/Williams et al/Chudy have been discussed above.

Schoonen/Williams et al/Chudy combined lacks the authorization code not being reused.

Momich et al. disclose that "usually a prescription from a physician includes: name of medication and dosage/strength, number of pills (or some other measure of quantity) and frequency, number of repeats allowed, name of user, prescribing doctor, date issued" (col. 12 lines 10+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an authorization code issued by a doctor on a card taught by Schoonen/Williams/Chudy and having a doctor's prescription issued date as taught by Momich et al. for comparison in obtaining prescription to avoid stealing from unscrupulous or drug dependent individuals who may steal/snatch the card from the patient to obtain drugs.

Remarks

7. Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's arguments with respect to the combination of Schoonen/Nomich would not produce the claimed invention. It is submitted that the authorization code, taught by Schoonen/Nomic, once issued by the physician and used at the dispensing machine, the same authorization code can not be used again to at least obtain the same drug since the prescription drug at the location in the dispenser has been taken by the patient. Event if in the situation in Applicant's argument that the same prescription can be given to the patient on the same day, the location of the new drug would be at different location, therefore the new authorization code would be different. As to when the patient loses the card and never obtain the drug, the same code can be given since it has not been used so there would be no "reuse" in this case. The Examiner notices that the instant application disclosure does not offer much support as to what makes up the code or its intended use for the disputed claim limitation except for in claim 7 which cites "authorization code not capable of being reused for other prescriptions". Moreover, the claim limitation is rather ambiguous in a sense that if the used numbers are to be "discarded", at what point this number will be maximum and rolls over since it is believed that a processor to date can generate an up to 128-bit code. It is questionable whether the code reader in the dispenser would be capable of reading a code that is beyond this limitation. Therefore, the interpretation of the disputed limitation can be broad and can be based on the support given in claim 7. See passage below from MPEP § 2100:

"The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1)."

In response to Applicant's arguments with respect to claim 7 that Schoonen/Nomic does not teach the amended claim limitation(s), it is noted that The combined teachings of Schoonen/Nomich would result in the patient inputting the authorization code into the dispenser and the patient entering separate (interpreted as being different or distinct from - see dictionary.reference.com) patient authorization date into the dispenser; and the dispenser determining whether the authorization code correlates to the patient authorization date (by comparing the its signal having known correlated/related information about the patient including authorization and date therein with that from the card)

In response to Applicant's arguments with respect to the combined teachings Schoonen/Williams/Chudy do not teach the claimed invention of claim 12, it is respectfully submitted that Schoonen discloses the scanning of the drug to verify proper drug being delivered (col. 2 lines 45-50: "checks, by means of the detecting means,

whether the drug identification code, detected by the detecting means, of the drug selected by the conveying means corresponds to the drug identification code determined for the cartridge in question from the data storage unit") and the dispenser can have a labeling mechanism (taught by Williams and Chudy combined). It is also recognized that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Denenberg et al. (US 6,464,142) discloses a method that includes receiving a unique identification number including order number, prescription number, date/time, ...

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Thien T Mai
Examiner
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May 07

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